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John Border

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EXAMINER

STRANGE, AARON N

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/996,445  
Filing Date: November 28, 2001  
Appellant(s): BORDER ET AL.

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Errol A. Krass  
Reg. No. 60,090  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/16/08 appealing from the Office action mailed 7/25/2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 8-12, 15, 17-19, 22, 24-26, 29, 31-36 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regard to claim 1, the limitation "forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable" is not enabled by the specification. The specification states that objects that have a time to live are cacheable (¶41, Lines 9-10). Since a cacheable object would never be marked "uncacheable", there is no way to forward an object based on this criteria, since no object would ever satisfy the criteria.

Based on ¶41 of the specification and Applicant's arguments, it appears that Applicant may have intended for these to be alternative criteria for forwarding, rather than complimentary criteria, but the current claim language does not capture such a relationship. Independent claims 8, 15, 22 and 35 are rejected under the same rationale, since they contain a substantially identical limitation.

All claims not individually rejected are rejected by virtue of the dependency from the above claims.

#### **(10) Response to Argument**

All pending claims are included within the first stated rejection under 35 U.S.C. § 112, first paragraph. Appellants argue all independent claims collectively, and present no separate arguments to any of the dependent claims encompassed by this rejection. Accordingly, the Examiner will address claim 1 as representative of all claims on appeal.

A summary of the various points raised by Appellants is presented below, and each point is addressed individually by the Examiner.

Regarding independent claim 1:

a) Appellants argue that the forwarding of short time-to-live is consistent with the forwarding of uncacheable objects, as described in ¶41 of the specification (Br. 7-8).

**b)** Appellants argue that the claim limitation "forward the object based on a predetermined criteria relating to the object, **including** time to live of the object **and** the object being marked as uncacheable" (emphasis added) is "merely a statement that these two criteria exist together on a list of predetermined criteria relating to the object" and "[t]he use of the conjunctive 'and' does not require that both of the listed criteria actually be employed each and every time a forwarding decision is made" (Br. 8-9).

**In reply to argument a)** that forwarding objects with a short time-to-live is consistent with the forwarding of uncacheable objects (Br. 7-8), the Examiner respectfully disagrees. The specification clearly and unambiguously states that "upstream server 107 may ... forward objects which have a short time to live since such objects, **while cacheable**, are less likely to still be fresh in the downstream server cache 115." (Spec. ¶41).

One of ordinary skill in the art would have understood this passage to mean that objects with a short time to live are cacheable. In fact, the very purpose of using a time-to-live for objects is to ensure that they are removed from a cache before they become outdated. Furthermore, the objects in the above cited passage **are already cached**, since they are "less likely to be fresh in the downstream cache".

There is simply no reasonable interpretation of ¶41 of the specification where objects with a short time to live, or even a long time to live, are uncacheable. The language of the specification makes it clear that these objects are cacheable, and that they are forwarded because of concerns regarding the freshness of the cached copy of

the object. Therefore, it is clear that an object with a short time to live will **never** be marked uncacheable.

Since objects with a time-to-live will never be marked uncacheable, it is simply not possible to forward an object based on a predetermined criteria including the time-to-live of the object and the object being marked uncacheable. Since no amount of experimentation would enable one of ordinary skill in the art to make and use the invention, the presently claimed invention fails to satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph.

**In reply to argument b)** that the claim limitation "forward the object based on a predetermined criteria relating to the object, **including** time to live of the object **and** the object being marked as uncacheable" is a an open ended list of criteria from which only one criteria is necessarily used in the forwarding criteria (Br. 8-9), the Examiner respectfully disagrees. Such an interpretation of the claim language is inconsistent with the plain language of the claim as well as the prosecution history of the present application.

As an initial matter, it is noted that the claim does not state forward based on a criteria including *at least one of* the two criteria, forwarding based on criterion 1 *or* criterion 2, forwarding based on a criterion selected from the group consisting of two criteria, or any other language presenting the two criteria as alternatives.

The plain language of the claim requires forwarding the object based on two criteria, the "time-to-live of the object" and "the object being marked as uncacheable".

Regardless of whether Appellants meant for the claim to mean something else, the language of the claim is clear. It is noted that Appellants have had numerous opportunities to amend the claim to clearly recite their intended meaning. Any of the above provided examples would clearly claim the two criteria as alternatives and have resulted in the Examiner treating them as such. The Examiner even recommended that Appellants contact the Examiner to discuss mutually acceptable claim language (Non-Final Office Action of 2/15/07, §11). However, Appellants chose not to do so, instead insisting on maintaining the present claim language despite the convoluted interpretation it requires to arrive at what appears to be Appellants' desired claim scope.

It is also noted that that Appellants' proposed interpretation is inconsistent with the prosecution history of the present application. When the first variation of this limitation was added by amendment, it stated "the predetermined criteria including size of the object **or** life of the object" (emphasis added) (Claim 2 filed 4/20/2005). This limitation clearly reads as an alternative listing of two criteria, and was interpreted as such by the Examiner.

The single criterion "life of the object" was incorporated into claim 1 on 10/20/2005 after the "size of the object" was found in the prior art (Office Action of 6/30/2005, §25), and amended to become "time-to-live of the object" on 5/15/2006. Also on 5/15/2006, an additional criterion was added, resulting in the limitation "forward the object based on a predetermined criteria relating to the object, including time-to-live of



the object **and** the object not being marked as uncacheable" (emphasis added). This limitation was subsequently amended to its present form on 10/30/06.

Appellants repeatedly presented arguments to the cacheability aspect of the claim limitation (Remarks of 5/15/06, 11; Remarks of 10/30/06, 9-10) while ignoring the "time-to-live of the object" as a criterion. Such an argument is inconsistent with a listing of possible criteria, since Appellants are undoubtedly aware that only one criterion from a list of alternative criteria must be present in the prior art to anticipate the entire list.

It is additionally noted that Appellants proposed interpretation of the claimed criteria as alternatives, if accepted, will not be allowable over the prior art of record. The limitation "forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object not being marked as uncacheable" (emphasis added) has been previously rejected in the Office Action of 7/28/2006. Interpreting the present criteria as alternatives would require reinstatement of that rejection.

In summary, Appellants have proposed an interpretation of the claim language that is inconsistent with the plain meaning of the claim language as well as the prosecution history of the present application. Despite having opportunities to amend the claims and being offered the Examiner's assistance in obviating the present rejection by making a minor amendment, Appellants have declined and instead elected to file this appeal.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Aaron Strange/

Examiner, Art Unit 2153

Conferees:

/Glenton B. Burgess/

Supervisory Patent Examiner, Art Unit 2153

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151